

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Patent Interference No. 105,135

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**SCRIPPS RESEARCH INSTITUTE**  
(5,622,931),  
Junior Party,

v.

**GENENTECH, INC.**  
(08/437,989 and 08/444,934),  
Senior Party.

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Entered: 25 May 2005

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**Judgment - Bd. R. 127(b) - Requested**

Before TORCZON, MEDLEY, and POTEATE, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

Scripps has stated that it will not contest priority (Paper 87). This statement is treated as a request for adverse judgment. Bd.R. 127(b). A third party involved in a related interference was permitted to file a paper in this case commenting on the judgment. The paper has been filed (Paper 89), but is limited to stating an understanding that the judgment will be "for Senior Party, Genentech, Inc., for claims 4-6, 8, 20, 21, 23, 27, 28, 31-36, and 41 of U.S.S.N. 08/444,934."<sup>1</sup> These claims are all of the claims in the 08/444,934 application that correspond to the count. Both of the involved claims from Genentech's 08/437,989 application have been determined to be

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<sup>1</sup> As a technical matter, since a priority determination is a rejection under 35 U.S.C. 102(g)(1), a judgment is against the losing party's claims rather than for the other party's claims.

unpatentable (Paper 83). The parties were authorized (Paper 87) to file a response to Paper 89, but in view of the limited nature of the comment, the authorization is withdrawn as moot.

DECIDED that judgment on priority be entered against Scripps for the subject matter of the count;

FURTHER DECIDED that Scripps' patent claims 1 and 2 be canceled;

FURTHER DECIDED that Genentech's 08/437,989 application claims 22 and 39 be held unpatentable; and

FURTHER DECIDED that a copy of this decision be entered in the administrative records of Genentech's 08/437,989 and 08/444,934 applications and Scripps' 5,622,931 patent.

cc (via electronic mail):

For Scripps Research Institute: **Talivaldis Cepuritis** and **Dolores T. Kenney**, OLSON & HIERL, LTD. of Chicago, Illinois.

For Genentech, Inc.: **R. Danny Huntington** and **Sharon E. Crane**, BINGHAM MCCUTCHEN LLP of Washington, D.C.

courtesy copy (via electronic mail):

For Nemerson: **Patrea L. Pabst**, PABST PATENT GROUP LLP of Atlanta, Georgia.

**Notice:** Agreements and understandings regarding the termination of an interference are subject to filing requirements under 35 U.S.C. 135(c).

**Notice:** In the event of judicial review, note the requirements of Bd. R. 8(b).

**Despertt, Sonja**

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**From:** Despertt, Sonja on behalf of Interference Trial Section  
**Sent:** Wednesday, May 25, 2005 2:39 PM  
**To:** 'Cepuritis, Talivaldis (OLSON & HIERL)'; 'Kenney, Dolores (OLSON & HIERL)'; 'Huntington, Danny (BINGHAM McCUTCHEN)'; 'Crane, Sharon (BINGHAM McCUTCHEN)'  
**Cc:** 'Pabst, Patrea (PABST PATENT)'  
**Subject:** Interference No. 105135 (RT) Paper No. 90 - JUDGMENT- Bd.R. 127(b)



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